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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,632	10/06/2005	Ronald Forbes	63070(50024)	7115
21874 7590 06/09/2009 EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205				
EXAMINER				
GOLDMAN, MICHAEL H				
ART UNIT		PAPER NUMBER		
3688				
MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/527,632

Applicant(s)

FORBES, RONALD

Examiner

MICHAEL H. GOLDMAN

Art Unit

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-29, 32-41, 43-46 and 48-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-29, 32-41, 43-46 and 48-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The following final action on the After Final filing on May 21, 2009.

Claims 1-26, 30-31, 42-43, and 47 were previously cancelled. Claims 27, 33, 39, 45, 51, 53, and 55 have been amended to overcome minor objections. Therefore, Claims 27-29, 32-41, 43-46 and 48-55 are currently pending and have been considered below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claims 27, 28, 32-40, 44-46, and 48-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petrovich (7,155,405) in view of and Kashio ((7,009,650).

Claim 27, 39 and 51: Petrovich discloses a system and method comprising:

a database for storing the display capabilities and picture messaging protocols of mobile devices (see column 2, lines 14-15 whereby item information (display capabilities and picture messaging protocols) input to and stored in the m-commerce device, also see column 1, lines 45-47 whereby promotions (to mobile devices) can be delivered in the form of banners (pictures) which are either static or animated bitmaps);

a mobile device (see FIG 1, item 102, mobile device);

a mobile device type identifier associated with said mobile device (see column 16, lines 45-50 whereby personally owned compatible m-commerce devices may be utilized with the disclosed system, the database 1000 may include an association of unique device IDs of a plurality of portable devices with the names of device owners, examiner construes database 1000 as storing the capabilities of mobile devices);

message processor that generates message data comprising a coupon (see column 22, lines 35-37 whereby the m-commerce device receiving an electronic coupon in response to the data form being read, examiner interprets mobile device (m-commerce device) receiving coupon from the system as message processor generating message data comprising a coupon, also see FIG 1, item 124, local m-com server (processor) and FIG 2, item 216 'system (generates) transmits data to portable device');

a message optimizer that generates an optimized message responsive to the stored display capabilities and picture messaging protocols corresponding to said mobile device type identifier (see column 16, lines 45 and continued to column 17, line 37 whereby personally owned compatible m-commerce devices may be utilized with the disclosed system, the database 1000

may include an association of unique device IDs of a plurality of portable devices with the names of device owners, examiner construes an association of unique device IDs as message optimizer responsive to capabilities corresponding to mobile device via type identifier, message data and stored data of mobile device, furthermore data transmitted to the mobile device is not limited to a textual format, but may include PDF including text, data and biometrics, examiner interprets the limitations of data transmitted as subject to the corresponding mobile device identifier); and communication module that transmits said optimized message to said mobile device (see FIG 1);

wherein said coupon comprises a barcode image (see column 17, line 11 whereby the dataform (coupon) may be an optically scanable barcode (image)).

However, Petrovich fails to explicitly disclose wherein said message optimizer generates said optimized message by downgrading said data message responsive to said stored display capabilities and picture messaging protocols.

Kashio discloses the feature whereby mobile devices in a network can be 'discovered', 'configured' and used by other devices (see abstract, lines 1-15, also see column 1, line 62 through column 3, line 12 whereby a data communications device utilizes the display area effectively by enhancing the visual effects and image quality without causing decreased visibility through image deterioration, a data communications system, a document display method with video and a document display program with video, also see Figs. 5, 6, 11, 13, 15 and 18).

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the invention of Petrovich to include the feature wherein said message optimizer generates said optimized message by downgrading said data message responsive to said stored

display capabilities and picture messaging protocols as taught by Kashio to overcome the managements of users with mobile devices having many different architectures in order to reach all potential users or conversely not preclude any potential users.

Claim 28 and 40: Petrovich and Kashio disclose the invention as in claim 27 and 39 above, and Petrovich further discloses a system characterized in that capabilities comprise at least one device attribute associated with a mobile device (see column 17, lines 24-28).

Claim 32, 36-38, 44, and 48-50 Petrovich and Kashio disclose the invention as in claims 27 and 39 above, and further discloses a system characterized in that said coupon comprises a barcode number, barcode symbology, a barcode image (see column 17, line 11 whereby the dataform (coupon) may be an optically scanable barcode (image). Examiner interprets use of an optically scanable barcode (image) to inherently include the associated technology of a barcode generator, means for generating barcodes, barcode encoder, and encoding said generated barcodes.

Claim 33, 34, 45, and 46: Petrovich and Kashio disclose the invention as in claim 27 and 39 above, and Petrovich further discloses a system characterized in that capabilities comprise multimedia content including video, audio or a photograph (see column 18, line 7 'multimedia advertising', also see column 20, line 1 'images, audio and video files').

Claim 35: Petrovich and Kashio disclose the invention as in claim 27 above, and Petrovich further discloses a system characterized in that message data further comprises mobile device type identifier (see column 1, lines 40-43 whereby marketing messages can be sent directly to the customer via his or her m-commerce device based upon their locations or other triggers, examiner construes message data as inherently comprising mobile device type identifier).

Claim 52 and 54: Petrovich and Kashio disclose the invention as in claim 27 and 39 above, and Petrovich further discloses wherein said message processor starts automatically in response to delivery of message content comprising a barcode number and a barcode symbology (see column 17, lines 5-29 whereby terminal 104 triggers automatic activation of the transponder system to expose the encoded dataform (barcode) code to the receiving system).

Claim 53: Petrovich and Kashio disclose the invention as in claim 27 and 39 above, and Petrovich further discloses wherein said communications modules comprises a plurality of gateways for transmitting said optimized message to a network; and said communication module comprises a router for selecting at least one of said plurality of gateways for message transmission, said selecting being based on rules (see Fig 1. containing a plurality of inputs and output devices in a network, which inherently has a router to direct traffic; see Fig 2 for rules).

4. Claims 29 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petrovich (7,155,405) and Kashio (7,009,650) in view of Lundy (7,305,442)

Claim 29 and 41: Petrovich and Kashio disclose the invention in claim 28 and 40 above, however fails to disclose a system characterized in that capabilities of mobile device comprising a display dimension and/or color depth.

Lundy discloses the feature whereby a system characterization of capabilities of a mobile device comprise a color depth (see column 1, lines 33-34 'a computer or wireless terminal may receive the advertisement, also see column 6, lines 19-21 whereby the display may include color graphics (color depth)).

Therefore, it would have been obvious for one skilled in the art at the time of the invention to modify the invention of Petrovich to include the features of color depth in the mobile device display as taught by Lundy in order to provide more effective attention getting advertisements, thereby increasing the number of transactions.

Response to Arguments

5. Applicant's arguments with respect to claims 2729, 32-41, 44-46, and 48-55 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL H. GOLDMAN whose telephone number is (571)270-5101. The examiner can normally be reached on Monday thru Thursday 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Myhre can be reached on 571-272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mhg
June 8, 2009

/James W Myhre/
Supervisory Patent Examiner, Art Unit 3688